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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,193	03/25/2002	Jean-Pierre Molitor	H 4157 PCT/US	1128

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COGNIS CORPORATION
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EXAMINER	
MARX, IRENE	
ART UNIT	**PAPER NUMBER**
1651	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,193	MOLITOR ET AL.	
	Examiner	Art Unit	
	Irene Marx	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-35* is/are pending in the application.

4a) Of the above claim(s) *23-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed 11/10/04 is acknowledged. Claims 12-22 are being considered on the merits.

Claims 23-35 are withdrawn from consideration as directed to a non-elected invention.

This application contains claims 23-35 drawn to an invention nonelected with traverse in Paper filed 3/15/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Upon reconsideration, the rejection under 35 U.S.C § 102 is no longer maintained.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-22 are/remain rejected under 35 U.S.C. 103(a) as being unpatentable over Inlow *et al.* taken with Kopp-Holtwiesche (DE 3738812)and Forster *et al.* (WO 95/11660) for the reasons as stated in the last Office action and the further reasons below.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the references pertain to the addition of triglycerides or fatty acid alkyl esters to media suitable for culturing microorganisms or for sustaining their growth. It is noted in this regard that at least Inlow *et al.* and Kopp-Holtwiesche are directed to culture media comprising microorganisms. While Forster *et al.* do not specifically address the intended use of the composition, the medium

disclosed surely is not permanently sterile and would comprise at least a few microorganisms upon opening. The medium disclosed would be suitable for the culturing of a fatty acid degrading strain such as the *C. tropicalis* strain disclosed by Kopp-Holtwiesche that degrades at least fatty acid components of triglycerides (See, e.g., Example 3).

Note still further that, contrary to applicant's argument, it is well established that motivation for combining references need not come from the references themselves, as long as applicant's disclosure is not improperly used in a hindsight reconstruction of the claimed invention. *See Ex parte Levengood*, 28 USPQ2d 1300 (1993), at 1301. ("Motivation for combining the references need not be explicitly found in the references themselves. Indeed, the examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness.")(Citations omitted.)

With respect to applicant's arguments that one of ordinary skill in the art would not have modified the culture medium of Inlow according to the teachings of Kopp-Holtwiesche because lauric acid methyl esters are not part of an emulsion used in the reaction medium. However, inasmuch as the amount of emulsion contained in the present culture medium is not disclosed, it is uncertain that all of the medium is emulsified. It is noted that the composition of Kopp-Holtwiesche would have been reasonably expected by one of ordinary skill in the art to be naturally emulsified at least to some extent as a consequence of agitation (See, e.g., Examples). In addition a reaction medium is no more than a composition that supports the growth of a microorganism.

Applicant also argues the intended use of Inlow as compared to Kopp-Holtwiesche for Forster. However, in each instance the reaction medium disclosed is suitable for the culturing and growth of microorganisms. It is submitted that the composition of Forster is not sterile upon opening and, thus, comprises a microorganism.

With respect to the size of the microemulsion particles, it is clear that at least some of the particles disclosed by Inlow fall within the required range of 50 to 400 nm. The other ingredients contained in the composition are nowhere excluded from the present invention which is broadly directed to an emulsion comprising water, an emulsifier and an oil phase (Response, page 3, paragraph 2).

Therefore the rejection is deemed proper and it is adhered to.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irene Marx
Primary Examiner
Art Unit 1651